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| 09/427,986      | 10/27/1999  | JOHN SAKSUN SR.      | SAK007/JTN          | 4058             |

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EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

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14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/427,986

Applicant(s)

SAKSUN, JOHN

Examiner

EDMUND H LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003 and 23 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 27-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Bradley et al (USPN 3212783) in view of Schmidt et al (USPN 5626530) and Burr (USPN 3218072). In regard to claim 1, Bradley et al teach the basic claimed process including positioning weights within a mold (col 3, ln 38-col 5, ln 60; figs 1-4); positioning a tubular metal shaft anchoring element having a smooth internal bore within the mold (col 3, ln 38-col 5, ln 60; figs 1-4)--as a note, figures 1-3 and 6 illustrate a smooth internal bore; molding a main body around the weights and the shaft anchoring element to form a metal-lined shaft receiving bore in the main body through the anchoring element (col 3, ln 38-col 5, ln 60; figs 1-4); and forming a metal to resin bond between the outside surface of the shaft anchoring element and the main body (col 3, ln 38-col 5, ln 60; figs 1-4). However, Bradley et al does not teach using a tubular shaft having a roughened outside surface; and forming a front face on the main body. In regard to a tubular shaft having a roughened outside surface, Schmidt et al teach forming a golf club head (col 4, ln 66-col 5, ln 15); and roughening a bonding surface in order to enhance the attachment of a composite film thereto (col 4, ln 66-col 5, ln 15). Bradley et al and Schmidt et al are combinable because they are analogous with respect to golf

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club heads and to bonding a plastic material to a metal surface. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to roughen the outside surface of the shaft of Bradley et al as taught by Schmidt et al in order to enhance the bonding of the molding material of Bradley et al to the shaft of Bradley et al. In regard to forming a front face on the main body, Burr teaches molding an insert/front face into a golf club head of either metal or plastic in order to gain more distance (col 1, lns 10-70; figs 1-4). Bradley et al and Burr are combinable because they are analogous with respect to molding golf clubs. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a front face in the golf club head of Bradley et al in order to increase distance. In regard to claims 28-34, Bradley et al teach securing the weights on mounting pins (col 3, ln 38-col 5, ln 60; figs 1-4); and providing an attachment screw generally perpendicular to the receiving bore (col 3, ln 38-col 5, ln 60; figs 1-4). However, Bradley et al does not teach molding a front insert pocket; machining an insert pocket; molding an insert into the insert pocket; machining a desired loft and grooves into the front face; and passing the attachment pin through the anchoring element. Burr teaches molding or machining a recess into a golf club head; and molding an insert into the recess (col 2, ln 70-col 3, ln 13; figs 1-4). Bradley et al and Burr are combinable for the reasons stated above. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to either mold or machine a recess into the face of Bradley et al and then molding an insert therein as taught by Burr in order to mold a club that hits longer. In regard to machining a desired loft and grooves into the front face, such is

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well-known in the golf club art in order to produce clubs with different distances and playability. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to machine a desired loft and grooves into the face of the club of Bradley et al (modified) in order to achieve the above result. In regard to passing the attachment pin through the anchoring element, such is well-known in the golf club art in order to prevent the shaft from moving because of the torque created by the swing. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made pass the attachment screw of Bradley et al completely through the anchoring element of Bradley et al in order to achieve the above result.

3. Applicant's arguments with respect to claims 27-34 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's argument that the formation of a plastic insert in a metal striking face is contradictory to the plain teachings of the references, metal heads having plastic face inserts are notoriously well-known in the golf club art. The inserts are usually designed to improve feel without reducing distance performance.

In response to Applicant hindsight argument, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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In response Applicant's argument that the instant invention uses a separate tubular anchoring element, such argument is moot since the instant claims do not require a separate tubular anchoring element. Claim 1 merely recites "positioning a tubular metal shaft anchoring element...within a mold." There is no mention that element is separate from the weights.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McGeeney et al (USPN 5938543) teach a golf club head having a metal striking face with a plastic face insert therein.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H LEE whose telephone number is 703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD CRISPINO can be reached on 703.308.3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7718 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

  
EDMUND H LEE  
Examiner  
Art Unit 1732  
6/16/03

EHL  
June 16, 2003